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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/631,981

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George Martinez

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EXAMINER

ADAMS, AMANDA S

ART UNIT

PAPER NUMBER

3731

MAIL DATE

DELIVERY MODE

05/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/631,981

Applicant(s)

MARTINEZ, GEORGE

Examiner

Amanda Adams

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. Claims 1-39 of this application conflict with claims 1-10 and 13-25 of Application No. 11/089207. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 5-7, 14-18, 20-22, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al (US 6,723,108).

3. Jones et al disclose the invention substantially as claimed including an elongate flexible inner element ([20] and col. 5, lines 13-16), a non metallic intermediate element surrounding and in intimate contact with the inner element ([22]), and an outer element coaxially surrounding and in intimate contact with the intermediate element defining a gap or opening through which the intermediate element is exposed ([12]). Jones et al disclose that the inner element is composed of a biocompatible material that is either metal wire or a polymeric filament (col.5, lines 21-25) and has a coupling element on the proximal end (col. 5, lines 18-20), and the intermediate element includes an expansile polymeric material that consists of a hydrogel that includes either a therapeutic compound or a bioactive agent (col. 5, lines 50-56).

4. Claims 1, 4, 9, 14, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Villar et al (US 6,287,318), hereinafter referred to as Villar.

5. Regarding claims 1 and 14, Villar discloses the invention substantially as claimed including an elongate, flexible, filamentous inner element (fig. 7 [174]); a non-metallic intermediate element coaxially surrounding the inner element and in intimate contact therewith (fig. 7 [172] or fig. 4 [142]; col. 3, lines 62-65; the intimate contact between the members is at the ends of the inner and intermediate members where the end cap is part of the intermediate member); and an outer element coaxially surrounding the intermediate element and in intimate contact therewith (fig. 4 [144])—this same outer element appears in fig. 7 although it is not labeled; the intimate contact is seen in the figures), the outer element defining a gap or opening through which the intermediate element is exposed (figs 4 and 7).

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6. Regarding claims 4 and 19, Villar discloses that the outer element includes an open wound, helically-coiled portion that defines the gap or opening through which the intermediate element is exposed (the threads of the outer element are helically wound with each other to form a mesh-like outer element. The spaces between the components of the outer element are the gaps or openings).

7. Regarding claims 9 and 24, Villar further discloses the outer element has an axial length and includes a plurality of openings along its axial length (the gaps are the openings as defined in claim 4), and wherein the intermediate element, when expanded, extends through the openings of the outer element to form an exterior surface having an undulating configuration defining a chain of convexly-curved arcuate segments (fig. 7, the coil shape of the intermediate element extends through the openings of the outer element; each segment of the intermediate element that shows through is an arcuate segment, thus creating the convexly-curved chain.).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (US 6,723,108) in view of Dutta (US 6,623,450).

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Jones et al disclose the invention substantially as claimed above but fail to disclose the environmental parameter consisting of either temperature or pH. However, Dutta teaches that it is old and well-known in the art for a hydrogel to expand in response to a change in either temperature or pH (col. 2, lines 26-35). These are both parameters that define differences between blood and its surrounding environment. Therefore it would have been obvious to have a hydrogel that expands under these conditions as the intermediate layer so that it expands only when it is supposed to, that is when it recognizes the temperature or the pH of intravascular blood.

Allowable Subject Matter

10. Claims 10-13 and 25-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Additionally, these claims are also rejected under 37 CFR 1.78(b) for double patenting.

11. Claims 29-39 would be allowable except that they are rejected under 37 CFR 1.78(b) which is a double-patenting rejection. Other than the double patenting rejection, which appears earlier in this office action, none of the cited references disclose or fairly suggest all of the limitations of these claims, in particular the limitation wherein the open wound helical coil is attached to the inner element and the limitation wherein the intermediate element is an expansile polymer that meets all the structural limitations of the outer element as well.

Response to Arguments

12. Applicant's arguments with respect to the use of Jones et al as prior art were considered but not found to be persuasive, for reasons explained on the record during a telephone interview on February 15, 2007. However, amendment to claim 9 has been acknowledged, and it has been decided that the amended claim 9 overcomes the previous rejection. However, a new rejection has been made in view of Villar et al, which was also found capable of rejection previously indicated allowable subject matter of claim 4.

13. Examiner agrees that claims 35- 39 should be indicated as allowable because they depend off of allowable claim 29; however, these claims are still not allowable in view of the double patenting rejection made previously in this office action.

14. Amendments to the specification have been acknowledged.

15. Amendments to claim 9 made to overcome the rejection under 35 USC 112 have been acknowledged and the rejection has been withdrawn.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,449,369 and US 5,522,822.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda Adams whose telephone number is (571) 272-5577. The examiner can normally be reached on M-F, 8:00am-5:00pm, alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ASA

ASA 4/19/07



GLEN K. DAWSON
PRIMARY EXAMINER